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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,263	12/10/2001	Nabil M. Lawandy	109960.223US2	4505

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

db8

Office Action Summary	Application No.	Applicant(s)	
	10/016,263	LAWANDY ET AL.	
	Examiner	Art Unit	
	Martin J Angebrannt	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/02 & 7/3/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1756

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/67085 A (LAWANDY et al.)

WO 99/67085 A (LAWANDY et al.) teaches in embodiment 4, a layer for rendering an optical recording medium unreadable over time. The medium is a polymeric layer containing silica gel (an absorbent/scavenger material) and benzyl alcohol. After time the polymeric layer becomes crazed and cloudy. (page 28/line 34-29/6). The use of two or more layers based upon evaporation is disclosed. (29/8-34). Example 3 tests the process by sealing the material in a ziplock bag. (28/4-31). The use of sublimation of acid or base producing materials or from a solution entrained in a polymeric layer is disclosed. The use of gasses dissolved in water, which change in pH due to the evolution and evaporation of the gas is disclosed. This is also disclosed as being used to detect various compounds, including amines and carbon dioxide. (30/4-32).

With respect to figures 6, the reference teaches the use of a diffusion barrier together with a layer, which contains oxygen and a photoinitiator/photosensitizer, which generates singlet oxygen upon irradiation. (20/11-22/15) The use of two different solvents having different polarity and volatility together with colorless dyes and a polar polymer is disclosed. The polyhydroxystyrene polymer is disclosed as able to cause coloration as well and the mixture remains colorless until the solvent is removed. (25/27-27/11). The use of various solvents is disclosed, including NMP (27/2), acetone (21/32), methanol (21/30) and other solvents.

It would have been obvious to one skilled in the art to modify the process of example 4 by providing the layer on an optical recording medium as it is disclosed as this is the disclosed purpose and sealing the result in a ziplock bag to test the shelf-life/stability of the resultant protected medium in a manner similar to that used in example 3 as testing is disclosed as desirable. Further, it would have been obvious to use solvents disclosed, such as NMP, acetone or methanol in place of the benzyl alcohol with a reasonable expectation of achieving comparable results. The silica is considered to be a diffusion barrier material for the solvent within the meaning of the claims set forth on pages 8-9 with respect to figure 12, which details that the "diffusion barrier can be a layer or substance that is presently part of the disk, thus requiring no additional layers or added materials". The embodiment where multiple layers are present discussed on page 29 of the reference is considered to address the embodiments of claim 10.

3. Claims 1-6, 8-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/67085 A (LAWANDY et al.) in further view of US 5,183,763 B (MALLOW et al.).

US 5,183,763 B (MALLOW et al.) teach the use of silica together with leuco dyes, where the presence the pH of the composition changes. (4/1-12). The use of various solvents is disclosed. (4/10-27). The use of nitric acid in the compositions is disclosed in the examples.

In addition to the above, it would have been obvious to one skilled in the art to modify the invention of WO 99/67085 A (LAWANDY et al.) which uses the leuco dyes dispersed in a polar binder together with mixed solvents by adding the silica to control the amount of solvent and its evaporation as in example 4 with a reasonable expectation of achieving the desired result based upon the direction within US 5,183,763 B (MALLOW et al.) evidencing the use of silica

together with leuco dyes in color evolving gas detection systems

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/67085 A (LAWANDY et al.) in view of US 5,183,763 B (MALLOW et al.) and US 4,800,193 A (Saeki et al.).

US 4,800,193 A (Saeki et al.) teaches the use of nitric, hydrochloric or other inorganic acids or metal halides as developers to cause coloration of leuco dyes. (7/12-17).

In addition to the basis provided above, it would have been obvious to obvious to modify the combination of WO 99/67085 A (LAWANDY et al.) and US 5,183,763 B (MALLOW et al.) by using hydrochloric acid, rather than nitric acid based upon the disclosure of equivalence of these acids in leuco dyes based color evolving systems.

5. Claims 1-6, 8-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. '262.

Lawandy et al. '262 teaches with respect to figure 16, a color blocking agent (CBA) which which may be placed on a patch or swab of a fibrous or porous material or a CBA absorbing material, such as a polymer. The use of a porous membrane is disclosed. The opening of the packaging depletes the CBA (16/38-17/27). The use of various solvents, including NMP (10/17) ethanol (10/41) and other volatile solvents is disclosed.

It would have been obvious to one skilled in the art to modify the invention of figure 16 by using a CBA absorbing material based upon the disclosure to do so.

6. Claims 1-6, 8-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. '892.

Lawandy et al. '262 teaches with respect to figure 6, a color blocking agent (CBA) which

Art Unit: 1756

which may be placed on a patch or swab of a fibrous or porous material or a CBA absorbing material, such as a polymer. The use of a porous membrane is disclosed. The opening of the packaging depletes the CBA (6/20-52). The use of various solvents, including NMP, ethanol and other volatile solvents is disclosed.

It would have been obvious to one skilled in the art to modify the invention of figure 6 by using a CBA absorbing material based upon the disclosure to do so.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-6, 8-16 and 18-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-28 and 34-36 of U.S. Patent No. 6,489,892. Although the conflicting claims are not identical, they are not patentably distinct from each other because they seek coverage for the same embodiments. See section [0024] of instant application and compare with claims 23 and 34 of the patent..

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

Art Unit: 1756

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9309 for regular communications and 703-872-9309 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J Angebrannt
Primary Examiner
Art Unit 1756

December 16, 2003